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**PATENT APPLICATION**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Brian William HOLMES et al.

Group Art Unit: 2872

Application No.: 10/520,368

Filed: July 13, 2006

Docket No.: 122347

For: OPTICALLY VARIABLE SECURITY DEVICE

**RENEWED PETITION UNDER 37 C.F.R. §1.497(d)**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In reply to the February 26, 2008 Decision ("Decision") (copy attached) regarding the above named Applicants' February 12, 2008 Renewed Petition Under 37 C.F.R. §1.497(d) ("Petition"), the following information is provided.

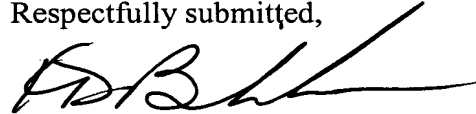
The Decision states that the Applicants' Response is being treated under 37 C.F.R. §1.497(d) and sets forth the requirements of §1.497(d). The Decision acknowledges receipt and/or completion of the requirements for a processing fee set forth in §1.17(i), a new Declaration, as stipulated in §1.497(d)(4), and a statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part. The Decision asserts that the proper written consent of the Assignee has not been provided.

Applicants submit a statement of the Assignee, executed by Mr. Rodger Prowen for De La Rue International Limited, consenting to the removal of Dr. Drinkwater as a named inventor.

Accordingly, it is respectfully submitted that Brian W. Holmes is the sole named inventor of this application, and that the Declaration submitted September 13, 2007 be accepted in accordance with 37 C.F.R. §1.497(d).

Should any questions arise regarding this correspondence, all inquiries may be directed to Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



James A. Oliff  
Registration No. 27,075

Kirk D. Berkheimer  
Registration No. 59,874

JAO:KDB/mab

Attachments:

Copy of U.S. Patent and Trademark Office Decision in response to Applicants' February 12, 2008 "Response to Decision"  
Statement of Mr. Prowen dated April 8, 2008

Date: April 24, 2008

**OLIFF & BERRIDGE, PLC**  
**P.O. Box 19928**  
**Alexandria, Virginia 22320**  
**Telephone: (703) 836-6400**

DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461
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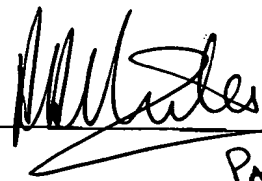
**STATEMENT OF  
MR. RODGER PROWEN FOR DE LA RUE INTERNATIONAL LIMITED,  
UNDER 37 C.F.R. §3.73(b)**

I, Mr. Rodger Prowen, hereby acknowledge and accept that Dr. Kenneth J. Drinkwater is not an inventor of International Application PCT/GB02/03174, and pending U.S. National Phase Application Serial No. 10/520,368, and hereby agree, on behalf of De La Rue International Limited, to the removal of Dr. Kenneth J. Drinkwater as a named inventor. It is my understanding that the inclusion of Dr. Drinkwater as an inventor in the original filing of this application was done in error and without deceptive intent. An assignment has been recorded in the U.S. Patent and Trademark Office at reel 018831, frame 0670.

I am authorized to sign this statement on behalf of De La Rue International Limited.

8TH APRIL 2008  
Date

  
Mr. Rodger Prowen

  
Witness

Attachment:  
Assignment

PAUL D. MILES  
118, UPPER BRIGHTON RD,  
WORTHING,  
WEST SUSSEX  
U.K. BN14 9JB

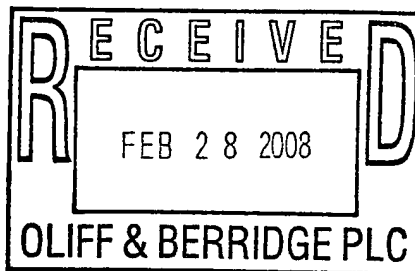


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KDB

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P.O. BOX 19928  
ALEXANDRIA, VA 22320

In re Application of HOLMES et al  
U.S. Application No.: 10/520,368  
PCT Application No.: PCT/GB2002/003174  
Int. Filing Date: 10 July 2002  
Priority Date Claimed: (none)  
Attorney Docket No.: 122347  
For: OPTICALLY VARIABLE SECURITY  
DEVICE

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DECISION

This is in response to applicant's "Renewed Petition Under 37 C.F.R. §1.497(d)" filed 12 February 2008.

### BACKGROUND

On 10 July 2002, applicant filed international application PCT/GB2002/003174. A copy of the international application was communicated to the USPTO from the International Bureau on 22 January 2004. The thirty-month period for paying the basic national fee in the United States expired on 10 January 2005.

On 06 January 2005, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, *inter alia*, the basic national fee required by 35 U.S.C. 371(c)(1).

On 03 May 2006, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905), which indicated that an oath or declaration in compliance with 37 CFR 1.497 must be filed.

On 28 June 2006, applicant filed a petition under 37 CFR 1.47(a) along with an executed declaration.

On 13 March 2007, this Office mailed a decision dismissing the 28 June 2006 petition.

On 05 September 2007, the DO/EO/US mailed a Notice of Acceptance of Application Under 35 U.S.C. 371 (Form PCT/DO/EO/903).

DOCKETED  
By me on 2-28 2008  
and  
By mp on 2/28 2008  
Oliff & Berridge

On 13 September 2007, applicant filed a petition under 37 CFR 1.497(d).

On 25 October 2007, this Office mailed a decision dismissing the 13 September 2007 petition.

On 12 February 2008, applicant filed the present renewed petition under 37 CFR 1.497(d).

### **DISCUSSION**

37 CFR 1.497(d) states,

If the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and this section names an inventive entity different from the inventive entity set forth in the international application, or if a change to the inventive entity has been effected under PCT Rule 92bis subsequent to the execution of any oath or declaration which was filed in the application under PCT Rule 4.17(iv) or this section and the inventive entity thus changed is different from the inventive entity identified in any such oath or declaration, applicant must submit:

- (1) A statement from each person being added as an inventor and from each person being deleted as an inventor that any error in inventorship in the international application occurred without deceptive intention on his or her part;
- (2) The processing fee set forth in § 1.17(i); and
- (3) If an assignment has been executed by any of the original named inventors, the written consent of the assignee (see § 3.73(b) of this chapter); and
- (4) Any new oath or declaration required by paragraph (f) of this section.

Applicant has previously satisfied items (2) and (4) above.

With regard to item (1) above, the renewed petition includes an appropriate statement from the person being deleted as an inventor.

With regard to item (3) above, proper written consent of the assignee De La Rue International Limited has not been provided. In particular, the person signing the statement of consent neither has apparent authority to sign on behalf of the assignee nor states that he is authorized to act on behalf of the assignee. See MPEP 324, Section V. Additionally, the statement refers to "De La Rue, PLC" rather than De La Rue International Limited, which is listed on the recorded assignment.

### **CONCLUSION**

For the reasons above, the renewed petition under 37 CFR 1.497(d) is DISMISSED without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.497(d)". No additional petition fee is required.

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

*Bryan Lin*

Bryan Lin  
PCT Legal Examiner  
PCT Legal Office

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